

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 2, 4, 5, 45-47, and 52-71 are pending in this application. Claims 3, 6-44, and 48-51 were previously canceled without prejudice or disclaimer. Claims 1, 4, 46, 54, 56, and 59 are amended to address the formal matters raised relative to the below noted rejection under the second paragraph of 35 U.S.C. §112 without the introduction of any new matter. Claims 70 and 71 are added to cover the plural gate electrodes in the embodiment of elected FIG. 8 that are illustrated by the cross-sectional view of FIG. 8 shown by FIG. 1, for example. Accordingly, new Claims 70 and 71 clearly correspond to the embodiment of elected FIG. 8 and clearly do not introduce any new matter.

In the outstanding Office Action, Claims 1, 2, 4, 5, 45-47, and 52-71 were rejected under the second paragraph of 35 U.S.C. §112, Claims 1, 2, 4, 5, 45-47, and 52-71 were rejected under 35 U.S.C. § 101 as being inoperative and, thus, lacking utility, and Claims 1, 2, 4, 5, 45-47, and 52-71 were rejected under 35 U.S.C. § 103(a) as unpatentable over Sugawara et al. (U.S. Patent No. 6,342,709, herein "Sugawara") in view of Applicants' admitted art (AAA).

The rejection of Claims 1, 2, 4, 5, 45-47, and 52-71 under the second paragraph of 35 U.S.C. §112 and the rejection of Claims 1, 2, 4, 5, 45-47, and 52-71 under 35 U.S.C. § 101 were both based upon the previous language of base independent Claims 1 and 56 reciting that "the main electrodes and the gate wiring is not electrically connected to the main electrodes" and the observation that the recitation would deny that the sources connected to the main electrodes would not be electrically connected to the gate wiring. Accordingly, base independent Claims 1 and 56 have been amended to better recite that --the gate wiring is

separated from the main electrodes by a second insulating film--. Consequently, the withdrawal of the rejection of Claims 1, 2, 4, 5, 45-47, and 52-71 under the second paragraph of 35 U.S.C. §112 and the withdrawal of the rejection of Claims 1, 2, 4, 5, 45-47, and 52-71 under 35 U.S.C. § 101 are respectfully submitted to be in order.

Turning to the rejection of Claims 1, 2, 4, 5, 45-47, and 52-71 under 35 U.S.C. § 103(a) as unpatentable over Sugawara in view of AAA, it is noted that the outstanding Action has erred at least as to interpreting Sugawara to teach that terminal Tg is “formed on the semiconductor layer via a first insulating film,” that terminal Tg is taught to be a metal, that terminal Ts is an electrode like electrode 11, and that the diagrammatic showings of the wires to the circular terminals Tg and Ts illustrated by Figures 8 and 9 (the Figures showing the terminal Ts) are drawn to scale such that the illustrated lengths of the lines from the gate electrodes 14 to the circular terminals Tg and the illustrated length of the line from the source electrode 11 to the circular terminal Ts can be relied upon as done at the bottom of page 4 of the outstanding Action.

Turning to the last point first, it is clear that under controlling precedent the outstanding Action errs in presuming that the illustrated lengths of the lines from the gate electrodes 14 to the circles serving to represent terminals Tg and the illustrated length of the line from the source electrode 11 to the circles serving to represent terminals Ts can be relied upon as has been done at the bottom of page 4 of the outstanding Action. However, *Hockerson-Halberstadt, Inc. v. Avia Group, Int'l, Inc.*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) establishes that “[such arguments hinged] on an inference drawn from certain figures about the quantitative relationship between the respective [dimensions] of [illustrated elements are not proper].” The court went on to emphasize that this was so because “it is well established that patent drawings do not define the precise proportions of

the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”

Here, the specification of Sugawara is completely silent as to the relative lengths of the lines illustrated to be between each circle representing each terminal and the element on the other end of that line. Moreover, these lines themselves are diagrammatic representations and not showings of physical wiring as should be clear from the illustrated penetration of each line from each terminal circle TG into the interior of each gate electrode 14.

Also, as the circles Tg representing the gate terminals are not formed on anything, they cannot be said to be “gate wiring which is formed on the semiconductor layer via a first insulating film” as Claim 1 recites. Also, claim1 recites that this gate wiring “is made of metal” (claim 56 also requires “metal gate wiring”) and the materials used for the circular terminals and connecting lines of FIGS. 8 and 9 are not disclosed by Sugawara. Also, Sugawara does not teach or suggest that the circular terminals Tg or the connecting lines from these terminals Tg of FIGS. 8 and 9 are not separated from “the main electrodes by a second insulating film” as amended Claims 1 and 56 recite.

Moreover, the teaching of col. 5, lines 6-7 of Sugawara is that “TS is a source terminal, TD is a drain terminal, and TG is a gate terminal,” which the outstanding Action twists into a teaching of gate wiring Tg and main electrodes 11, Ts. However, interpretations by the PTO cannot substitute for actual reference teachings and it is thus the reference that must teach that gate terminal Tg is a gate wiring and that Ts together with electrodes 11 constitute main electrodes with an upper surface defined by terminal Ts and not electrode 11. *See In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). *Kotzab* establishes that it is the use of the terms by the reference itself that controls, not the PTO interpretation of such terms that ignores this controlling reference usage.

The relied on “AAA” does not cure the above noted deficiencies of Sugawara such that independent Claims 1 and 56 clearly patentably define over the relied upon combination of Sugawara in view of “AAA” for at least the above-noted reasons.

Furthermore, if the lengths of the lines leading to Tg and Ts are to be presumed to be accurate, then the nonexistent width of these lines must also be presumed to be accurate. However, it is clear that the flat connecting plate of the “AAA” cannot be supported by the thin line under Ts and that there would be no reasonable expectation that it could. Accordingly, as applying the connecting plate to the device of Sugawara would duplicate the existing function of the terminal Ts and would further collapse the line from Ts to electrode 11 and short to the gate terminals Tg, there is no rational underpinning for the suggested modification. As recently noted by the Supreme Court, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006)).

Claims 2, 4, 5, 45-47 and 52-69 depend from independent Claims 1 or 56. Accordingly, these dependent claims clearly define over the applied combination of Sugawara in view of “AAA” for at least the above-noted reasons set forth as to these independent claims, as well as because each of these dependent claims adds further features to those of base independent Claims 1 and 56 that are not taught or suggested by this combination.

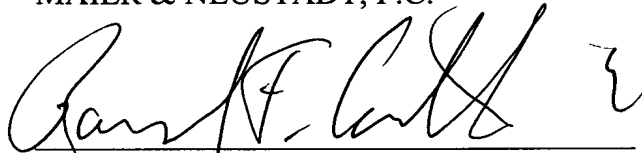
New Claim 70 depends from Claim 1 and new Claim 71 depends from Claim 56. Accordingly, these new claims clearly define over the relied upon combination for at least the above-noted reasons set forth as to these independent claims, as well as because each of these dependent claims adds further features to those of base independent Claims 1 and 56 that are not taught or suggested by this combination as to the recited the second semiconductor

regions not being formed on a second side of the plurality of gate electrodes that is an inner side in which the gate wiring is located. Accordingly, it is respectfully submitted that new Claims 70 and 71 are allowable for the reasons discussed above.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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